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Date: April 27, 2006

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Attorney Docket: 081468/0307015
Client Reference: P-1749.000 -US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of:

Confirmation Number: 8897

TEN BERGE et al.

Application No.: 10/724,403

Group Art Unit: 2826

Filed: December 1, 2003

Examiner: Leonardo ANDUJAR

Title: SUBSTRATE, METHOD OF PREPARING A SUBSTRATE, METHOD OF MEASUREMENT, LITHOGRAPHIC APPARATUS, DEVICE MANUFACTURING METHOD AND DEVICE MANUFACTURED THEREBY, AND MACHINE-READABLE STORAGE MEDIUM

RESPONSE TO SECOND RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This responds, with traverse, to the Second Restriction Requirement (dated March 27, 2006) in connection with the above-identified patent application.

THE FIRST RESTRICTION REQUIREMENT

The Examiner made a first requirement for restriction on December 8, 2005 between the following groups of claims:

- Group I. Claims 1-24, drawn to a method of preparing a substrate; and
- Group II. Claims 26-28, drawn to a substrate having alignment marks.

PREVIOUS ELECTION

In order to comply with the First Restriction Requirement, Applicants elected to prosecute Group I, directed to claims 1-24, and reserved the right to file a

Divisional application directed to the non-elected claims at a later date, if so desired.

The election was made without traverse on January 8, 2006.

Thus, claims 1-24 remain pending in the present application.

THE SECOND RESTRICTION REQUIREMENT

The Examiner made a second requirement for restriction on March 27, 2006 between the following groups of claims:

- Group I. Claims 1-11, which according to the Examiner, are drawn to a method of preparing a substrate; and
- Group II. Claims 12-15, which according to the Examiner, are drawn to a method of determining an orientation of a crystal axis of a substrate.

RESPONSE TO SECOND RESTRICTION REQUIREMENT

The second restriction requirement is improper because it fails to consider all of the claims pending in the present application. Claims 1-24 remain pending. The second restriction requirement addresses only claims 1-15, and the associated "Office Action Summary" erroneously states that only claims 1-20 are pending, that claims 16-28 are withdrawn from consideration, and that claims 1-15 are subject to a restriction requirement.

Applicants' counsel initially responded to the Examiner by telephone. During a telephone interview on April 25, 2006, Applicants' counsel requested that the second restriction requirement be withdrawn in view of its erroneous basis. The Examiner, however, was unwilling to withdraw the restriction requirement and instead requested that a formal response be filed.

Pursuant to the Examiner's request, Applicant traverses and respectfully requests withdrawal of the improper, second restriction requirement. Applicant cannot respond adequately because it is not clear which group pertains to the other remaining claims 16-24. For compliance with 37 C.F.R. 1.143, however, Applicant **provisionally elects, with traverse**, Group I, directed to claims 1-11.

The second restriction requirement also should be withdrawn because, in addition to the aforementioned defects, it fails to comply with M.P.E.P. §803. In particular, it is respectfully submitted that the remaining claims 1-24 in this application may be searched and examined without a serious burden. M.P.E.P. §803 states: "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." (Underlining emphasis added) Notably, the second restriction requirement, if maintained as to Groups I and II, would result in the withdrawal of only four claims (claims 12-15) from consideration. It is also respectfully noted that the claims in non-elected Group II include features that overlap in subject matter with features recited in the claims of provisionally elected Group I.

In view of the substantial overlap, it is respectfully submitted that the search for Group I necessarily includes the search for Group II. As the search for Group I necessarily includes the search for Group II, it is respectfully submitted that the search and examination of all remaining claims 1-24 in the application can be made without a serious burden.

Applicants therefore respectfully request withdrawal of the second restriction requirement and examination on the merits of all remaining claims (1-24) in this application.

Respectfully submitted,
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